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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,073	07/06/2005	Roland Kratzer	09086-00217-US	4476
34872	7590	02/05/2007		
BASELL USA INC. INTELLECTUAL PROPERTY 912 APPLETON ROAD ELKTON, MD 21921			EXAMINER MCDONOUGH, JAMES E	
			ART UNIT	PAPER NUMBER
			1755	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/05/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/521,073

Applicant(s)

KRATZER, ROLAND

Examiner

James E. McDonough

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

(1) Applicant's arguments, see page 2, paragraphs 1-4, filed 12/4/2006, with respect to previous claims 11 and new claim 31 have been fully considered and are persuasive. The rejection of claims 11 and 31 has been withdrawn. However, examiner request applicants to amend the specification (to 1-19 carbons from 1-16 carbons) to reflect this change in the claims.

(2) Applicant's arguments, see page 1, paragraph 1, to page 8, paragraph 4, filed 12/4/2006, with respect to previous claims 1-20 have been fully considered and are persuasive. The rejection of claims 1-20 has been withdrawn.

### ***Previous rejection***

(3) 4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohnen et al., USP 6,482,902 (hereafter referred to as Bohnen I) in view of Bohnen, USP 6,417,302" (hereafter referred to as Bohnen II). Bohnen I discloses the invention substantially as claimed when one considers that the combination of the active hydrogen-containing group (C) of the present claims plus the organometallic compound (B) of the present claims corresponds to the ingredient d) of col. 2, 1. 35-54 and examples 1-4 of the prior art (col. 2, 1. 14 to col. 3, 1. 16; col. 3, 1. 41 to col. 5, 1. 31, examples 1-4, 6, 8, 11, 13, 17-25). Bohnen I lacks disclosure of combining the all the reagents simultaneously without isolation of intermediates, i.e. a "one-pot" synthesis. However, Bohnen II teaches that combining reagents to make a one-pot synthesis of similar catalysts is conventional in the art (examples 1 and 7; col. 1, 1. 47 to col. 6, 1. 39). It would have been obvious to one of ordinary skill in the art to apply the teaching of Bohnen II to the disclosure of Bohnen I with a reasonable expectation of obtaining a highly- useful method of making a supported catalyst with the expected benefit of fewer steps and thus lower cost of production.

### ***Applicant's arguments***

(4) Claims 1-20 have been cancelled rendering the above rejection moot.

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Notwithstanding, the current application and the subject matter contained in U.S. Patent 6,482,902 (referred to herein as Bohnen, et al. I) is commonly owned, and Applicant was subject to an obligation of assignment to the owner of Bohnen, et al. I at the time the claimed inventive subject matter was made. Applicant has included herein as Attachment B (i) a copy of the Recordation of Assignment for the currently pending application, and (2) a copy of the assignee of record for Bohnen, et al. I from the U.S. Assignment database. Accordingly, Applicant respectfully believes Bohnen, et al. I is not prior art under 35 U.S.C. 103(c). Additionally, the U.S. Supreme Court in *Graham v. John Deere Co.*, 148 U.S.P.Q. 459 (1966) held that non-obviousness determined under §103 by (i) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the art; and, (4) inquiring as to any objective evidence of non-obviousness. To establish a prima facie case of obviousness, the Examiner must establish: (i) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970). As outlined in the Office Action on page 4, Bohnen, et al. II fails to teach, disclose, or suggest, "A process for preparing a catalyst solid for olefin polymerization by contacting, without any isolation of an intermediate, (A) at least one organic transition metal compound; (B) at least one organometallic compound of formula (V)  $MI(R1)_r(R2)_s(R3)_t(V)$  where MI R1 is an alkali metal, an alkaline earth metal, or a metal of group 13 of the Periodic Table, is hydrogen, Ci-C10-alkyl, C~C15-aryl, halo-C1-C10-alkyl, halo-C6-C1s-aryl, CT-C~0-arylalkyl, CT-C40 alkylaryl, C1-C10-alkoxy, halo-Cv-C40-alkylaryl, <c (D) (E) at least one support." Accordingly, Applicant kindly withdrawal this rejection. halo-CT-C40-arylalkyl, or halo-C1-C10-alkoxy, R2 and R3 are each hydrogen, halogen, Ci-C10-alkyl, C6-C15-aryl, halo-C1-C10-alkyl, halo-C6-C1s-aryl, CT-C40-arylalkyl, CT-C40-alkylaryl, Ci-C10-alkoxy, halo-CT-C40-alkylaryl, halo-CT-C40-arylalkyl, or halo-CI - Ci0 - al koxy; r is an integer from 1 to 3; and s and t are integers from 0 to 2, where the sum  $r+s+t$  corresponds to the valence of MI at least one organic compound comprising at least one functional group comprising active hydrogen, wherein the functional group is selected from the groups consisting of hydroxyl group, primary and secondary amino groups, mercapto groups, silanol groups, carboxyl groups, amido groups, and imido groups; at least one Lewis base; and requests the Examiner to withdraw this rejection.

### ***Respose to arguments***

(5) Applicants argue that Bohnen I was commonly owned at the time of the invention and therefore Bohnen I is not prior art under 35 USC 103(c). This argument is

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not persuasive because Bohnen qualifies as a 102(e) and therefore, is **not** disqualified as prior art under 35 USC 103(c).

(6) Applicants argue that examiner has not established a *prima facie* case of obviousness and that the references do not disclose "A process for preparing a catalyst solid for olefin polymerization by contacting, without any isolation of an intermediate. This is found not persuasive because Bohnen II clearly states that the catalyst can be isolated or reacted further in solution without isolation (column 6, lines 40-49). The motivation to combine is economic as a "one-pot" synthesis is less complicated and would lead to a lower cost of production and reduced preparation time.

**(7) THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

(8) A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

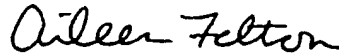
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(9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to James E. McDonough whose telephone number is (571)272-6398. The examiner can normally be reached on 8:30am-5:00pm.

(10) If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

(11) Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JEM 1/26/2007

  
AILEEN FELTON  
PRIMARY EXAMINER